



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:)	<u>Group Art Unit: 2677</u>
Xing-Zhi LIN)	<u>Examiner: K. Nguyen</u>
Serial Number: 10/620,334)	<u>Attorney Docket: LINX3001beu</u>
Filed: July 17, 2003)	<u>Confirmation No.: 8653</u>

For: Wireless Pointing Device With Power-Supplying Module

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Commissioner For Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The current claims have been twice rejected, so the appeal is appropriate even though the action was not made final.

The review is requested for the reasons stated on the attached sheets (no more than 5 pages are provided).

I am the attorney or agent of record.

Respectfully submitted,
BACON & THOMAS, PLLC

Date: February 4, 2009

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REASONS FOR REQUESTING REVIEW OF THE OUTSTANDING REJECTION
(Attachment to Pre-Appeal Brief Request for Review)

Review of the outstanding rejection of claims 1-6, 8, and 9 as being anticipated by U.S. Patent No. 7,089,291 (Philyaw) is requested on the grounds that the “opening” 3904 of Philyaw, alleged by the Examiner to correspond to the claimed opening, is an **opening in a power-supply module** rather than an **opening in a wireless input device** that is arranged to *receive* a power-supply module, as claimed.

It is respectfully noted that the outstanding rejection under 35 USC §102(b) **repeats** a rejection made in an Official Action dated October 29, 2007. This rejection was the subject of an interview (the **second** interview in the case), during which it was **agreed** that the rejection based on Philyaw would be overcome if the claims were amended to clarify that the “body” and “opening” were of the wireless input device rather than the power-supply module since, in the Philyaw device, batteries are inserted into an opening 3904 in the power-supply module rather than in the body of the input device. After the amendments were submitted in connection with an RCE (the **fifth** of six responses in the case), the Examiner **withdrew** the rejection and made a new rejection under 35 USC §103(a), which was subsequently overcome by further amendments. **The Examiner has now inexplicably repeated the original rejection under 35 USC §102(b), which was overcome by an interview and response, and which was withdrawn two office actions ago.** Not only is the rejection repeated, but the Examiner has even repeated the incorrect citation of 35 USC §102(b) when the rejection should have been made under 35 USC §102(e). In view of the Examiner’s reinstatement of previously overcome rejections, the Appellant believes that prosecution of this application could continue indefinitely if an appeal is not taken at this time.

The reason that the rejection is improper, and was previously overcome, is that the Philyaw patent neither discloses nor suggests a power supply module inserted into an opening

of the body of a wireless input device, as claimed, and which forms a part of the housing of the device when the power supply module is inserted into the opening. In particular, the body of cellular telephone 3702 of Philyaw does not include any sort of opening, as claimed, into which a power supply module can be inserted. While Philyaw does teach a battery pack having an opening, the battery pack is not a wireless input device, much less a wireless input device having an opening for a module into which batteries are inserted, as claimed. Graphically, this difference may be illustrated as follows:

Philyaw: batteries in sealed module attachable to cell phone

Claimed: batteries removably inserted into module \Rightarrow module inserted into opening in wireless input device \Rightarrow module forms part input device housing

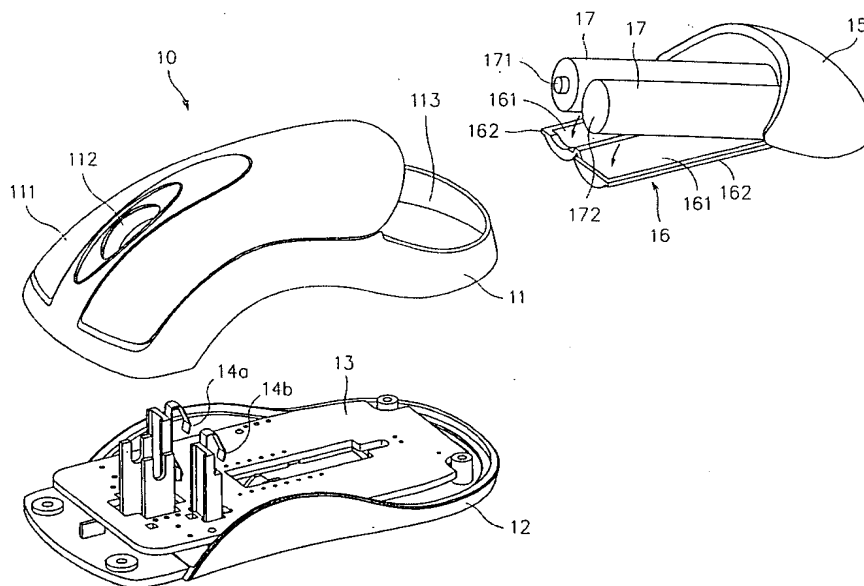


FIG. 2

Illustration of Claimed Device

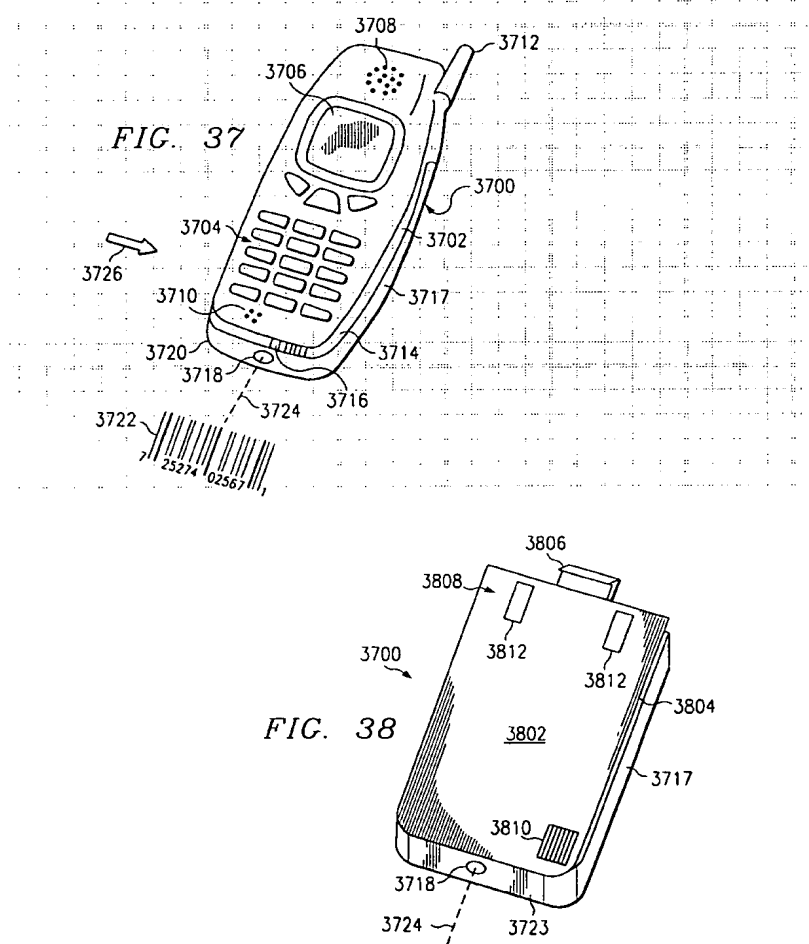


Illustration of Philyaw's Device

While Philyaw does disclose a battery pack (power-supply module) 3700, the battery pack of Philyaw is a power-supply module with an optical reader that **attaches to the back** of a cell phone body, outside the housing. This is not the same as providing for **insertion** of the pack **into** the body of the phone. The cell phone body does not include any opening into which the pack is inserted. Instead, the body includes contacts and a slot for receiving locking tab 3806. The

slot for receiving locking tab 3806 is the only opening in the cell phone body, but the slot is not large enough to receive the entire battery pack. Furthermore, there is no disclosure that the batteries 3906 of Philyaw can even be replaced. Instead, col. 32, lines 21-35 describe the batteries as rechargeable. If the reviewers have rechargeable cell phone power-supply modules, the reviewers will appreciate that the batteries in such modules are normally not replaceable. As a result, it is respectfully submitted that battery pack 3700 does not correspond to the claimed power-supply module, both because it does not provide for “replacement of the battery” as claimed, and also the module cannot reasonably be considered to be inserted into an opening in the cell phone body.

According to the Examiner, reference numeral 3717 of Philyaw indicates the claimed “body,” as explained in the last line on page 2 of the Official Action. However, reference numeral 3717 is actually the housing of the battery pack, and not the cell phone body. As explained in col. 31, lines 7-9 of the Philyaw patent:

The battery pack having an integral optical reader 3700 includes a housing 3717 which is adapted to be removably attachable to the cellular telephone 3702.

Col. 31, lines 31-36 go on to describe the manner of attachment to the telephone:

In this case, grooves 3804 are provided along the edges of the battery pack 3700 which slidably interface with projections (not shown) on the back face of the cellular telephone 3702. A locking tab 3806 is also provided which engages the telephone 3702 to prevent unintentional release of the battery back 3700.

Thus, the battery pack slides onto the back face of the telephone, and in no way is inserted into an opening in the body of the phone, there being no such opening.

It is true that when the battery pack 3700 is not attached to the phone 3702 of Philyaw, the body of the phone forms a notch or L-shaped surface for receiving the battery pack. However, the notch is not an “opening” in the body since the housing surface is continuous and unbroken in the area of the notch, and the battery pack cannot reasonably be considered to be inserted “into” the opening since it merely latches onto the outside of the housing surface. In

order to reasonably be considered an “opening” in the body, the notch would have to provide some ingress or access to the interior of the phone, which it does not.

Still further, with respect to claim 1, it is respectfully noted that a cellular telephone is not normally considered by those skilled in the art to be a “wireless input device,” as claimed. Instead, the phone of Philyaw only becomes a wireless input device when the power supply module 3700, which is also an optical reader, is connected to the phone. In contrast, the purpose of the claimed invention is to provide an easy way to change batteries in a wireless input device such as a computer mouse *without* having to replace the entire power-supply module. Once the module is withdrawn from the body, the old batteries can be taken out and new batteries inserted, and the entire module with fresh batteries re-inserted into the input device housing. In effect, the invention provides a **drawer** (as more explicitly recited in new claim 9) that can be pulled in and out to facilitate insertion and removal of the batteries of the input device. The battery pack of Philyaw, on the other hand, is not simply a drawer for replaceable batteries, but rather a sealed unit that itself functions as an input device (optical reader) for the cell phone, and that must be disposed of when the batteries contained therein no longer can carry a charge

As to the dependent claims, it is respectfully noted that claims 6 and 8 are clearly not anticipated by the Philyaw patent since these claims recite a computer mouse, trackball, and game controller, none of which are disclosed by Philyaw. In addition, Philyaw does not suggest the subject matter of new claim 9, which recites that the batteries are “**replaced on the carrier**” (rather than being part of a sealed battery pack) by drawing out the power supply module from the opening as if pulling out a drawer.

As a result of the above-described differences, the Philyaw patent does not anticipate the claimed invention, and reversal of the rejection under 35 USC §102 is respectfully requested.